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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/584,648

01/26/2007

Naomi Fujimori

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06/09/2010

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT

PAPER NUMBER

1783

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/584,648	<b>Applicant(s)</b> FUJIMORI ET AL.	
	<b>Examiner</b> ALICIA CHEVALIER	<b>Art Unit</b> 1783	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 March 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 15-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/26/06, 8/20/08, 10/27/09</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-32 are pending in the application, claims 15-31 are withdrawn from consideration.
2. Amendments to claims, filed on June 26, 2006, have been entered in the above-identified application.

### ***Election/Restrictions***

3. Applicant's election with traverse of Group I, claims 1-14 and 32, in the reply filed on March 15, 2010 is acknowledged. The traversal is on the ground(s) that a complete search and examination of the entire application could be made without serious burden. This is not found persuasive because the present application was filed on the national stage under 35 USC 371 and is evaluated by the criterion that unity of invention exists between multiple inventions only when these inventions share one or more "special technical features" in common with the understanding that these special technical features define a contribution which each of the inventions makes over the prior art. As stated in the office action mailed February 22, 2010, evidence of lack of unity between the groups is found in US Patent No. 2,046,000, wherein it is found to disclose the features of instant claim 23. As such, the special technical features of the claimed invention are not found to define a contribution over the prior art.

The requirement is still deemed proper and is therefore made FINAL.

4. Claims 15-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim.

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Applicant timely traversed the restriction (election) requirement in the reply filed on March 15, 2010.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-14 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Junji et al. (JP 05-254066), see English machine translation for prior art discussion.

Junji discloses an embossed release paper for synthetic leather production, comprising at least paper as a support (*page 7, paragraph [0027]*) and an ionizing radiation cured film provided on the paper, the upper part of the cured film having been embossed, characterized in that the radiation cured film has been formed by applying radiation to a coating liquid comprising at least a radiation curing composition having a softening point of 40°C or above, to cure the radiation curing composition, the radiation curing composition comprising a product of a reaction of an isocyanate compound with an (meth)acrylic compound containing an (meth)acryloyl group and reactive with the isocyanate compound (*page 3, paragraph [0006]*). Junji further discloses film further comprises 1 to 70% by weight of a film forming resin and 0.5 to 20% by weight of a silicone compound. A seal layer comprising an inorganic pigment and a film forming resin is provided on the surface of the support (*abstract*). The film has a multilayer structure of at least two layers (*page 5, paragraph [0016]*).

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The limitation “ionizing radiation cured” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Thursday from 11:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alicia Chevalier/  
Primary Examiner, Art Unit 1783  
6/10/2010